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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,917	07/03/2001	Siu-Leong Ju	067339-0033	3640
20277 7590 11/26/2008 MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096				
EXAMINER				
WINTER, JOHN M				
ART UNIT		PAPER NUMBER		
3685				
MAIL DATE		DELIVERY MODE		
11/26/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/763,917

Applicant(s)

IU ET AL.

Examiner

JOHN M. WINTER

Art Unit

3685

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-21, 23-30 and 62-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-21, 23-30 and 62-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Acknowledgements

1. The Applicants amendment filed on December 20, 2007 is acknowledged. Claims 19-30 and 62-77 remain pending.

Response to Arguments

2. The Applicant states that Chaum does not disclose warping by an amount not readily visible by a viewer.

The Examiner maintains the position that this is a subjective measure, since no specific quantitative measure is provided as to the amount of warping. The Examiner would like to point out that the language that Applicant considers lacking from the prior art references is directed towards intended use (e.g. "will be distorted and the distortion of the composite video image can be seen by the viewer, wherein said warping changes with time during playback of the video image") and it has been held that the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art- if the prior art has the capability to so perform (MPEP 2114 and *Ex parte Masham*, 2 USPQ2d 1647 (1987)). Similarly, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)).

Regarding a specific algorithm (see Applicant's arguments over "warping" page 4), Chaum discloses embedding unnoticeable, invisible and/or unrecognizable

information therefore, as it has been held that an obvious modification of the prior art would have been to substitute one technique for embedding ('717, column 9, lines 1-19) for another (*Ex parte Smith*, 83 USPQ2d 1509 (Bd. Pat. App. & Int. 2007)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. Claims 19,20,21,23-30 and 62-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads, (US Patent No 6,363,159) in view of Saito (US Patent 6,182,218) and further in view of Chaum (US Patent 5,959,717) and further in view of Official Notice.
4. As per claim 19,
- Rhoads ('159) discloses a playback unit, comprising:
- an input for receiving an encoded data stream bearing a video image;
- (Figures 2 and 3)
- Rhoads ('159) does not explicitly disclose "a decoder for decoding the encoded data stream;". Saito ('218) discloses "a decoder for decoding the encoded data stream; ",(Figure 1, column 8, lines 15-18). It would be obvious to one of ordinary skill in the art at the time of the invention to combine the Rhoads ('159)'s method with Saito's teaching in order to enforce digital rights management systems.

Rhoads ('159) does not explicitly disclose " means for imparting a prescribed transformation to the video image for warping the video image in a manner, and by an amount, not readily visible to a viewer such that a composite video image produced by multiple video playback units will be distorted and the distortion of the composite video image can be seen by the viewer, wherein said warping changes with time during playback of the video image ". Chaum ('717) discloses "means for imparting a prescribed transformation to the video image for warping the video image in a manner, and by an amount, not readily visible to a viewer such that a composite video image produced by multiple video playback units will be distorted and the distortion of the composite video image can be seen by the viewer, wherein said warping changes with time during playback of the video image "(Column 8, lines 57-67 – column 9 lines 1-9). It would be obvious to one of ordinary skill in the art at the time of the invention to combine the Rhoads ('159)'s method with Chaum ('717) teaching in order to enforce digital rights management systems.

Official Notice is taken that the various warping techniques as describe by claims 20,21,23-30 such as spline function, quadratic function are common and well known in prior art in reference to watermarking protocols. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a mathematical process to warp am image in order to create a predictable signature. Claims 20, 21 and 23-30 are not patentably distinct from claim 19 and are rejected for at least the same reasons.

5. As per claim 22,

Rhoads ('159) discloses a playback unit in accordance with claim 19,

Official Notice is taken that “warping changes upon scene change of said video image” is common and well known in prior art in reference to watermarking protocols. It would have been obvious to one having ordinary skill in the art at the time the invention was made to insert warping data into digital media at point when the scene changes in order to make the warped segment inconspicuous.

6. Claims 62-77 are not patentably distinct from claims 19, 20, 21, 23-30 and are rejected for at least the same reasons.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMW

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685